

REMARKS

Claims 1-22 were examined and reported in the Office Action. Claims 1-22 are rejected. Claims 1, 2, 5, 6, 8, 13, 15, 18, 20 and 21 are amended. Claims 1-22 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 102

A. It is asserted in the Office Action that claims 1-12 are rejected under 35 U.S.C. § 102(e), as being anticipated by U. S. Patent No. 6,694,354 issued to Elg ("Elg").

Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990))."

Applicant's amended claim 1 contains the limitations of "[a]n apparatus comprising: an electronic device for coupling to a home network system, the electronic device having a memory device, the memory device contains a remote location's complete address, wherein one of control and characteristic information for the electronic device is stored at a remote location from the electronic device, wherein the electronic device achieves plug-n-play capability without plug-n-play protocol."

Applicant's amended claim 6 contains the limitations of "a plurality of electronic devices each including a memory device, each of the memory devices contain a remote location's complete address, wherein one of control and characteristic information for

the electronic device is stored at a remote location from each of the plurality of electronic devices; a plurality of device specific buses coupled specifically to the plurality of electronic devices; a plurality of device specific network bridge devices coupled specifically to the plurality of device specific buses and a home network; and a device for communicating with a remote network, wherein each of the electronic devices achieve plug-n-play capability without plug-n-play protocol."

Elg discloses a computer system peripheral device that includes a first portion of a pointer that contains a device specific portion of the pointer. A computer in the system generates a second portion of the pointer that includes a location where device specific information is located. The computer combines the two portions into a single pointer to download device information. Elg, however, does not teach, disclose or suggest "the memory device contains a remote location's complete address, wherein one of control and characteristic information for the electronic device is stored at a remote location from the electronic device, wherein the electronic device achieves plug-n-play capability without plug-n-play protocol." Elg only discloses a device contains a portion of device information. That is, in Elg, if the computer is not present to generate the second portion of the pointer, then the device in Elg could not work toward the goal of downloading device information. In Applicant's claimed invention, the device contains all of the information necessary to find the characteristic or control information. Moreover, Elg must have a peripheral type of device in the computer system (i.e., a device typically found in a computer system), whereas Applicant's claimed invention only needs a home network system, which can be as simple as a controllable light switch that is plugged into a wall outlet (i.e., the house wiring is the transmission line for control signals). And, Applicant's claimed invention does not make use of plug-n-play protocol, which reduces costs associated with plug-n-play implementation.

Therefore, since Elg does not disclose, teach or suggest all of Applicant's amended claims 1 and 6 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Elg. Thus, Applicant's amended claims 1 and 6 are not anticipated by Elg. Additionally, the

claims that directly or indirectly depend on claims 1 and 6, namely claims 2-5, and 6-12, respectively, are also not anticipated by Elg for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejections for claims 1-12 are respectfully requested.

B. It is asserted in the Office Action that claims 13, 14, 18 and 19 are rejected under 35 U.S.C. § 102(e), as being anticipated by U. S. Patent No. 6,301,012 issued to White et al ("White"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

Applicant's amended claim 13 contains the limitations of "generating a request for a device's remote location complete address; receiving the requested device's complete address from the device; determining whether characteristic information for the device is previously stored on a home network system; communicating with the remote location if the device's characteristic information is not previously stored on the home network system; retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the home network system; controlling the device on the home network system, wherein the device achieves plug-n-play capability without plug-n-play protocol."

Applicant's amended claim 18 contains the limitations of "generating a request for a device's remote location complete address; receiving the requested device's complete address; determining whether characteristic information for the device is previously stored on a home network system; communicating with the remote location if the device's characteristic information is not previously stored on the home network system; retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the system; and controlling the device on the home network system, wherein the device achieves plug-n-play capability without plug-n-play protocol."

White discloses “plug and play” software residing in memory on a printer and a “network plug and play” module on a network I/O card on the printer. With the plug and play features a printer can be recognized and configured without user intervention. White discloses that information is retrieved from a file or disk on a computer system. White, however, does not teach, disclose or suggest “determining whether characteristic information for the device is previously stored on a home network system; communicating with the remote location if the device’s characteristic information is not previously stored on the home network system; retrieving the device’s characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the home network system; controlling the device on the home network system, wherein the device achieves plug-n-play capability without plug-n-play protocol.”

Therefore, since White does not disclose, teach or suggest all of Applicant’s amended claims 13 and 18 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(e) has not been adequately set forth relative to White. Thus, Applicant’s amended claims 13 and 18 are not anticipated by White. Additionally, the claims that directly or indirectly depend on claims 13 and 18, namely claims 14, and 19, respectively, are also not anticipated by White for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejections for claims 13, 14, 18 and 19 are respectfully requested.

II. 35 U.S.C. § 103

A. It is asserted in the Office Action that claims 15-17, and 20-22 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over White in view of Elg. Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142 “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there

must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." *"All words in a claim must be considered in judging the patentability of that claim against the prior art."* (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's amended claim 13 contains the limitations of "generating a request for a device's remote location complete address; receiving the requested device's complete address from the device; determining whether characteristic information for the device is previously stored on a home network system; communicating with the remote location if the device's characteristic information is not previously stored on the home network system; retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the home network system; controlling the device on the home network system, wherein the device achieves plug-n-play capability without plug-n-play protocol."

Applicant's amended claim 18 contains the limitations of "generating a request for a device's remote location complete address; receiving the requested device's complete address; determining whether characteristic information for the device is previously stored on a home network system; communicating with the remote location if the device's characteristic information is not previously stored on the home network system; retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the system; and controlling the device on the home network system, wherein the device achieves plug-n-play capability without plug-n-play protocol."

Elg discloses a computer system peripheral device that includes a first portion of a pointer that contains a device specific portion of the pointer. A computer in the system generates a second portion of the pointer that includes a location where device specific information is located. The computer combines the two portions into a single pointer to download device information.

White discloses "plug and play" software residing in memory on a printer and a "network plug and play" module on a network I/O card on the printer. With the plug and play features a printer can be recognized and configured without user intervention. White discloses that information is retrieved from a file or disk on a computer system.

Therefore, even if White were combined with Elg, the resulting invention would still not include all of Applicant's claimed limitations. More specifically, a resulting invention from the combination of teachings in White and Elg would not disclose, teach, or suggest "generating a request for a device's complete identification information; receiving the requested device's complete identification information; determining whether characteristic information for the device is previously stored on a home network system; communicating with a remote location if the device's characteristic information is not previously stored on the home network system; retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the system; and controlling the device on the home network system." And, therefore, there would be no motivation to combine White with Elg.

Moreover, by viewing the disclosures of White and Elg, one can not jump to the conclusion of obviousness without impermissible hindsight. According to MPEP 2142, [t]o reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences,' conduct the search and evaluate the

'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."

Applicant submits that without first reviewing Applicant's disclosure, no thought, whatsoever, would have been made to "generating a request for a device's remote location complete address; receiving the requested device's complete address; determining whether characteristic information for the device is previously stored on a home network system; communicating with the remote location if the device's characteristic information is not previously stored on the home network system; retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the system; and controlling the device on the home network system, wherein the device achieves plug-n-play capability without plug-n-play protocol."

Neither White, Elg, nor the combination of the two, teach, disclose or suggest the limitations contained in Applicant's amended claims 13 and 18, as listed above. Since neither White, Elg, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claims 13 and 18, as listed above, there would not be any motivation to arrive at Applicant's claimed invention. Thus, Applicant's amended claims 13 and 18 are not obvious over White in view of Elg since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 13 and 18, namely claims 15-17, and 20-22, respectively, would also not be obvious over White in view of Elg for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for Claims 15-17 and 20-22 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-22 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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Dated: December 7, 2004

By: _____

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on December 7, 2004.

Jean Svoboda